

EA



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,787	07/31/2001	Jeffry J. Grainger	020313-000520US	4834

20350 7590 09/22/2005

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

MOONEYHAM, JANICE A

ART UNIT	PAPER NUMBER
----------	--------------

3629

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/919,787

Applicant(s)

GRAINGER ET AL.

Examiner

Janice A. Mooneyham

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This is in response to the applicant's communication filed on July 31, 2001.

Claims 1-13 are currently pending.

Information Disclosure Statement

2. The information disclosure statements (IDSs) submitted on January 7, 2002, March 7, 2003, April 9, 2003, and August 23, 2004 are being considered by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The applicant uses the term "associating" in several of the steps in claim 1. The applicant claims "associating a first one or more of the plurality of electronic documents," "associating a second one or more of the plurality of electronic document," and "associating the at least one of the second one or more." It is unclear what the applicant means by the term "associating." Is applicant incorporating the information or connecting it in some way?

Claims 2 and 3 recite the limitation "the plurality of electronic patent documents".

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1-13 only recite an abstract idea. The recited steps of merely storing a plurality of electronic documents in a database and associating the documents does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea.

Art Unit: 3629

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble.

The trivial use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

The fact that the applicant stores documents in a database is not sufficient use of technology. The claim language could read on storing the electronic documents in a database while the associating steps occur outside the computer or in the users head. Receiving a signal from a user could be broadly read as someone telling another to select the document.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Rivette et al (US 6,877,137) (hereinafter referred to as Rivette).

Art Unit: 3629

Referring to Claim 1:

Rivette discloses a computer implemented method of managing electronic documents comprising:

storing a plurality of electronic documents in a database (Figure 5 (509); col. 25, lines 38-49);

associating a first one or more of the plurality of electronic documents to a first case (Figure 5; Figure 8; Figure 26; col. 26, lines 36-46);

associating a second one or more of the plurality of electronic documents to a second case (Figure 5);

receiving a select signal from a user, the select signal selecting at least one of the second one or more of the plurality of electronic documents associated with the second case to be associated with the first case (Figures 46-49; col. 31, lines 25-63)

associating the at least one of the second one or more of the plurality of electronic documents to the first case in response to the select signal (Figures 1-2; Col. 30, lines 36-59).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3629

6. Claims 2-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al (US 6,877, 137) (hereinafter referred as Rivette) in view of Stobbs et al (US 2004/0181427) (hereinafter referred to as Stobbs).

Referring to Claim 2-3:

Rivette discloses the method of claim 1. Rivette does not disclose the displayed documents being patent documents.

However, Stobbs discloses the documents displayed being patent documents ([0047-0048]; Figure 2; Figure 9).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the document linking method disclosed in Rivette the patent analysis taught in Stobbs so as to be able to perform a review of patent office records for potentially relevant patents and to provide a correlation from one patent to the next.

Referring to Claim 4:

Stobbs discloses displaying document references for the first and second one or more of the plurality of electronic documents associated with the first and second cases, respectively, in individual rows of a first column and displaying first and second case identifiers at the top of the top of second and third columns, wherein the rows of the second column include a marker when the electronic document corresponding to the row is associated with the first case, and wherein the rows of the third column include marker when the electronic document corresponding to the row is associated with the second case (Figure 2 (56)).

Art Unit: 3629

Referring to Claim 5:

Stobbs discloses wherein the first case and second case are related cases (Figure 7).

Referring to Claims 6-7:

Stobbs discloses wherein the first case and second case have the same assignee (Figure 18) and wherein the technological areas are searched (Figure 21).

Referring to Claims 8-9:

The fact that the cases relate to a continuation or a continuation in part is given little patentable weight. The method steps are performed to the same. In other words, the type of patent is not functionally interrelated with the steps of the claimed invention and thus is deemed to be non-functional descriptive data. See *In re Gulack*, 217 USPQ 401 (CAFC 1983), *In re Lowery*, 32 USPQ2d 1031 (CAFC 1994).

Referring to Claim 10:

Rivette discloses displaying a search screen to search for additional cases (Figure 24).

Referring to Claims 11-13:

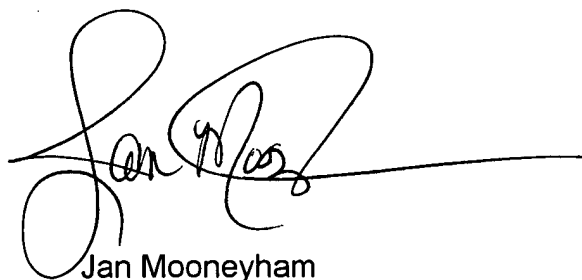
Rivette discloses a plurality of electronic documents (Figure 5). The fact that the document is an electronic version of a United States Patent, a foreign patent document or an electronic version or a publication is deemed to be non-functional descriptive data and thus is given little patentable weight.

Art Unit: 3629

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Jan Mooneyham", with a long horizontal line extending to the right.

Jan Mooneyham
Patent Examiner
Art Unit 3629